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| SERIAL NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
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| 087711,961 | 09/06/96 | BRANSTRUM | A 003/030/SAP |

18N2/0109

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| EXAMINER | |
|----------|--------------|
| VOGEL, N | |
| ART UNIT | PAPER NUMBER |
| 1805 | 5 |

DATE MAILED: 01/09/97

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.
08/711,961

Applicant(s)
Branstrom et al.

Examiner
Nancy T. Vogel

Group Art Unit
1805



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-44 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-44 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10 drawn to an attenuated Shigella, classified in class 435, subclass 252.1.
 - II. Claims 11-13, drawn to a method of reducing symptoms caused by Shigella, classified in class 424, subclass 93.4.
 - III. Claims 40-43, drawn to a method of detecting Shigella infection, classified in class 435, subclass 7.32.
 - IV. Claims 28-33 and 44, drawn to a method of delivering DNA to a cell, classified in class 435, subclass 172.3.
 - V. Claims 14-19, drawn to recombinant attenuated Shigella, classified in class 435, subclass 252.3.
 - VI. Claims 20-23, drawn to attenuated Shigella into which antigen has been introduced, classified in class 435, subclass 252.1.
 - VII. Claims 24-27, drawn to a method of oral immunization, classified in class 424, subclass 93.4.
 - VIII. Claims 34-39, drawn to a method of delivering an antigen, classified in class 424, subclass 93.1.

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2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in an assay to detect Shigella infection..

3. Inventions of Group I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used to reduce symptoms caused by Shigella.

4. Inventions of Groups I and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a method of detecting Shigella infection.

5. Restriction to one of the following inventions is required under 35 U.S.C. 121:

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6. The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups V and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in the production and purification of a desired recombinant protein product.

7. Inventions of Groups VI and VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used as a source for the production of Shigella proteins for purification..

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

9. A telephone call was made to Mr. John Moran on 12/10/96 to request an oral election to the above restriction requirement, but did not result in an election being made.

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Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nancy Vogel whose telephone number is (703) 308-0278. The examiner can normally be reached on Monday through Wednesday from 7:30AM to 3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mindy Fleisher, can be reached on (703) 308-0407. Certain papers related to this application may be submitted to Art Unit 1805 by facsimile transmission. Papers should be faxed to Art Unit 1805 via the PTO FAX Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see C.F.R. 1.6(d)). The Art Unit 1805 FAX number is (703) 308-0294.

NOTE: If Applicants **does** submit a paper by Fax, the original signed copy should be retained by applicant or applicant's representative. **NO DUPLICATE COPIES SHOULD BE SUBMITTED** so as to avoid the processing of duplicate papers in the Office.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.


NANCY T. VOGEL
PRIMARY EXAMINER
GROUP 1800